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### **REMARKS**

Claims 19 and 20 are added herein. Support for new Claim 19 is found in the specification, for example, at the paragraph spanning pages 8-9, through the paragraph spanning pages 9-10. Support for new Claim 20 is found in the specification, for example, at page 7, first two full paragraphs, and Example 1. No new matter is added by new Claims 19 and 20.

Claim 18 is canceled without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the canceled claim in this or any other patent application.

Upon entry of the amendments, Claims 8, 10-12, 14, 15, 19 and 20 are pending. Applicants respectfully request entry of the amendments and reconsideration of the application in view of the following remarks.

### **Rejection Under 35 U.S.C. §102(b)**

Claims 8, 10-12, 14 and 18 are rejected under 35 U.S.C. §102(b) as being anticipated by Masuda (U.S. Publication No. 2002/0064650). The Office Action states that Masuda discloses all elements of the claims.

#### **Masuda does not Disclose All Claim Elements**

Claims 8 and 14 are not anticipated by Masuda because Masuda does not disclose a film comprising a transparent adhesive layer formed on and in contact with one side of the base material film. Claims 8 and 14 recite that the film comprises a transparent adhesive layer formed on and in contact with one side of the base material film. Masuda, in contrast, discloses that on one side of the adhesive layer, an antistatic coating is present, and on the other side of the adhesive layer, no layer is present, so that the adhesive layer is accessible for pasting the film on window glass. *Masuda* at paragraph [0044]. Thus, Masuda does not disclose a film comprising a transparent adhesive layer formed on and in contact with one side of the base material film. As such, Masuda does not disclose a film possessing all elements of Claims 8 and 14. Therefore, Claims 8 and 14 are novel over Masuda.

The Office Action states that paragraph [0044] of Masuda provides an embodiment in which the antistatic layer is present on only one side, and, thus, in that embodiment, the adhesive

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layer is not formed on and in contact with the antistatic layer. The specific language of Masuda cited by the Office Action is Masuda's statement that, "it is preferable that the said antistatic coating be provided on both sides" of the polyester film. Applicants presume that the Office Action is asserting that this statement impliedly teaches a non-preferred embodiment in which the antistatic coating is not present on one side of the polyester film. Notwithstanding this assertion by the Office Action, even if Masuda teaches an embodiment in which no antistatic coating is present on one side of the polyester film, nothing in paragraph [0044] of Masuda provides a transparent adhesive layer formed on and in contact with one side of the base material film. Specifically, there is no express teaching at paragraph [0044] or elsewhere in Masuda that a transparent adhesive layer is formed on and in contact with one side of the base material film.

Masuda also does not inherently disclose this element. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *M.P.E.P.* §2112.IV, citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). Nothing in Masuda establishes that in any embodiment, a transparent adhesive layer is necessarily formed on and in contact with one side of the base material film is necessarily present. Masuda, at paragraph [0044], teaches, "On the side opposite from the hard coat of the polyester film of the present invention, a known sticking agent or adhesive is applied for pasting the film on window glass." However, as is acknowledged by the Office Action, this language does not refer to the adhesive layer being formed on and in contact with one side of the base material film because the preferred embodiment of paragraph [0044] has at least an antistatic layer intervening between the adhesive layer and the base film. Those skilled in the art are aware of any of a number of layers, such as a polarizing or dye-containing layer, that could be placed between the adhesive layer and the base film. As such, those skilled in the art would know that nothing in Masuda's paragraph [0044] or elsewhere, would require that an adhesive layer must necessarily be formed on and in contact with one side of the base material film. Therefore, nothing in Masuda inherently discloses this element.

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Claims 8 and 14 are not anticipated by Masuda because Masuda does not disclose a film comprising a transparent adhesive layer formed on and in contact with one side of the base material film. Masuda neither expressly nor inherently discloses this element. Accordingly, Masuda cannot anticipate the claims.

Furthermore, Masuda is directed to a co-extruded laminated polyester film comprising at least three polyester layers. *Masuda* at Abstract. The presently claimed invention is completely different from that of Masuda because the presently claimed base material a single-layer film. Accordingly, Masuda does not teach all elements as presently claimed.

In addition, the presently claimed invention is transparent and does not contain a dye. Masuda requires a dye in the film. *Masuda* at Abstract. As such, Masuda's film is completely different from that of the present claims. Accordingly, Masuda further cannot anticipate the present claims.

### **Rejection Under 35 U.S.C. §103**

Claims 8, 10-12, 14, 15 and 18 are rejected under 35 U.S.C. §103 as being obvious over Masuda's admitted prior art in view of Masuda. The Office Action states that Masuda's teachings of prior art establish that the hard coat is optional.

Masuda does not render Claim 8 or Claim 14 obvious because Masuda does no teach a transparent adhesive layer formed on and in contact with one side of the base material film. As Applicants have explained above, Masuda neither expressly nor inherently teaches a transparent adhesive layer formed on and in contact with one side of the base material film. Furthermore one of ordinary skill would not be lead by the teachings of Masuda to modify Masuda's teachings in order to arrive at Applicants' claimed invention. Specifically, one of ordinary skill would not be lead by the teachings of Masuda to produce a transparent adhesive layer formed on and in contact with one side of the base material film. Masuda, at paragraph [0044], clearly teaches that "it is preferable that the said antistatic coating be provided on both sides" of the polyester film. Thus, one of ordinary skill would be lead by Masuda to produce a film with at least an antistatic layer intervening between the transparent adhesive layer and the base film. Although other embodiments, *e.g.*, other intervening layers, might be among the less-preferred embodiments, there is no teaching in Masuda that would lead one of ordinary skill to produce a transparent

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adhesive layer formed on and in contact with one side of the base material film. Masuda does not even teach that a structure such as that claimed by Applicants is a less-preferred embodiment. The only teaching by Masuda is of a structure contrary to that which is claimed. As such, if anything, Masuda teaches away from the film of Claims 8 and 14.

### **Claim 15**

Even if Masuda rendered Claim 8 obvious, which Applicants do not concede, Masuda does not render Claim 15 obvious. Claim 15 is directed to the transparent surface protective film of Claim 8, consisting of: the transparent base material film, the transparent adhesive layer formed on one side of the base material film, and the transparent antistatic layer formed on the other side of the base material film. Thus, the invention of Claim 15 does not include a hard coat layer. Masuda, in contrast, teaches a film with a hard coat layer. In fact, Masuda teaches that the object of the invention is to provide a film with a hard coat layer:

The object of the present invention is to provide a film having excellent light-shielding effect, good coating and adhesive properties **with hard coating materials** and pastes (sticking agents and adhesives), and capable of long-time use as a light-shielding film for windows.

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According to the present invention, there is provided a film having excellent light-shielding effect, good coating and adhesive properties **with hard coating material** and paste (sticking agent or adhesive), and capable of long-time use after applied on window glass, so that its industrial value is high. *Masuda* at paragraphs [0009] and [0052] (emphasis added).

Masuda provides no embodiment in which the invention can be a film that does not possess a hard coating. Masuda's only teachings of any instance in which a hard coating might be absent is when Masuda characterizes problems with that which is in the prior art. In particular Masuda characterizes the problems in the prior art as:

These light-shielding films are mostly of a layer structure in which usually a hard coat is provided on one side while a paste is applied on the opposite side to attach a release film. In making such light-shielding films for windows, it usually needs to conduct solvent type hard coating and pasting. The problem involved in this operation is that static electricity is generated with a random or regular pattern on the film surface, so that when hard coating or pasting is performed on this film, there tends to arise coating irregularity of the same pattern as that of static electricity generated on the film surface. *Masuda* at paragraph [0004] (emphasis added).

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Thus, Masuda explains that the presence of a hard coating in prior art films can cause problems. Masuda's invention is to provide a hard coating-containing film that does not possess such problems. As is clear from the above, the hard coating is an essential component to Masuda's invention because Masuda's invention is to provide a film that possesses acceptable properties when a hard coating is present. As such, to remove the hard coating from Masuda's film would render Masuda's invention irrelevant and unsatisfactory for its intended purpose. It is well established that if proposed modification would render a prior art invention being modified unsatisfactory for its intended purpose, then the proposed modification is not obvious. *M.P.E.P. §2143.01.V, citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, since removing the hard coating from Masuda's invention would be unsatisfactory for purposes of Masuda's invention, such a modification is not an obvious modification of Masuda. Accordingly, Claim 15 is non-obvious over Masuda.

The Office Action points to the above-quoted portion of Masuda at paragraph [0004] as indicating that it was known in the art to provide films without hard coats. Notwithstanding this assertion, it would clearly be contrary to Masuda's invention to remove the hard coat layer since Masuda clearly teaches that the hard coat layer is central to Masuda's invention. Accordingly, whether or not it was known in the art to provide films without hard coats is not relevant because such a modification of Masuda's invention would be contrary to Masuda's teachings, and would render Masuda's invention unsatisfactory for its intended purpose. Accordingly, it is improper to modify Masuda's invention to remove the hard coat layer. Therefore, the film of Claim 15 is not rendered obvious by the teachings of Masuda.

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**CONCLUSION**

In light of the Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 7, 2008 By: /Kerry Taylor/  
Kerry Taylor  
Registration No. 43,947  
Attorney of Record  
Customer No. 20,995  
(619) 235-8550

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